

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD LYNN LINCECUM

Appeal No. 2006-0408
Application No. 09/775,451

ON BRIEF

Before KIMLIN, GARRIS and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-4, 6-8, 18 and 19.

The subject matter on appeal relates to a bag formed of a dual surface material comprising an outside surface having a particular coefficient of friction range and an inside surface having a coefficient of friction range lower than that of the

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outside surface. This lower coefficient of friction for the inside surface facilitates the placement of articles such as furniture inside the bag. Further details concerning this appealed subject matter are set forth in representative independent claims 1 and 18 which read as follows:

1. A bag formed of a dual surface material wherein said dual surface material comprises:

- a. an inside surface having a coefficient of friction range of approximately 0.125 to 0.275; and
- b. an outside surface having a coefficient of friction range of approximately 0.300 to 0.600.

18. A bag formed of a dual surface material wherein said dual surface material comprises:

- a. an outer polymer film layer having a coefficient of friction range of approximately 0.300 to 0.600; and
- b. an inner polymer film layer having a coefficient of friction less than said outer layer.

The reference set forth below is relied upon by the examiner as evidence of obviousness:

Sugimoto et al. 4,856,656 Aug. 15, 1989
(Sugimoto)

All of the appealed claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugimoto.

For a complete discussion of the contrary viewpoints expressed by the appellant and by the examiner concerning this rejection, we refer to the Brief and Reply Brief as well as to the Supplemental Examiner's Answer mailed May 20, 2005.¹

OPINION

For the reasons which follow, we cannot sustain the above-noted rejection.

As properly argued by the appellant and acknowledged by the examiner, Sugimoto discloses a bag (for enclosing articles such as furniture to be packaged) having inside and outside surfaces or layers which possess respective coefficients of friction that are the reverse of those claimed by the appellant. The examiner attempts to eliminate this deficiency in his conclusion of obviousness which is expressed in the paragraph bridging pages 5 and 6 of the Supplemental Answer as follows:

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have switched the outer and inner layers in the film for packaging of Sugimoto . . . depending on the end-use of the product, in order to produce a bag with an outer layer with a higher coefficient of friction

¹ As a matter of clarification, the Supplemental Examiner's Answer replaces the Answer mailed December 12, 2003 which failed to comply with certain established guidelines regarding a proper Examiner's Answer.

and a lower density than the inner layer so that an article can easily be removed from or placed in the bag, since it has been held that rearranging parts of an invention involves only routine skill in the art.
In re Japikse, [181 F.2d 1019] 86 USPQ 70 [CCPA 1950].

This obviousness conclusion is without merit in multiple respects.

First of all, the modification proposed by the examiner would render the prior art bag unsatisfactory for the intended purpose disclosed by Sugimoto. That is, the lower coefficient of friction surface of patentee's bag faces outwardly so as to allow sliding between the outer surface and buffering material (e.g., see element 4 in Figure 1) thereby preventing the packaged article inside the bag from being directly rubbed by the buffering material (see lines 51-64 in column 4). This desideratum would not be achieved if patentee's bag were modified in the manner proposed by the examiner. This infirmity of the examiner's rejection is discussed in more detail by the appellant on pages 9-10 of the Brief and pages 2-3 of the Reply Brief.

In addition, the examiner has completely misinterpreted the decisions of In re Japikse, 181 F.2d 1019, 86 USPQ 70 and

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Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987) as supporting his unpatentability determination. Rather than reiterate the examiner's failure in this respect, we refer to pages 13-15 of the Brief for a thorough exposition thereof.

Similarly, for reasons detailed by the appellant on pages 9-13 of the Brief and page 4 of the Reply Brief, the examiner has utterly failed to recognize that In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) militates for the appellant's patentability arguments and against the examiner's obviousness conclusion.

In short, Sugimoto contains no teaching or suggestion whatsoever for the modification proposed by the examiner. On the record of this appeal, it is only the appellant's own disclosure which contains any teaching or suggestion of such a modification. There can be no rational dispute, therefore, that the examiner has formulated his rejection based on impermissible hindsight derived from the appellant's own disclosure. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

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It follows that we cannot sustain the examiner's § 103 rejection of claims 1-4, 6-8, 11, 18 and 19 as being unpatentable over Sugimoto.

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin
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Administrative Patent Judge)
)
Bradley R. Garris
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